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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/602,989

06/24/2003

Raymond Edward Paggi

TH2189 (US)

3995

23632

7590

08/09/2006

SHELL OIL COMPANY

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EXAMINER

MCAVOY, ELLEN M

ART UNIT

PAPER NUMBER

1764

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/602,989	Applicant(s) PAGGI ET AL.	
	Examiner Ellen M. McAvoy	Art Unit 1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 47-49 is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/7/03; 6/24/03</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14 and 26-43 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the isocyanate compounds represented by the formula $R-(N=C=O)_x$, does not reasonably provide enablement for "at least one oil-dispersible source of HNCO" set forth in independent claims 1, 26 and 34. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to employ all oil-dispersible sources of HNCO as the invention commensurate in scope with these claims. It has been well established that there must be a reasonable correlation between the scope of the exclusive right granted to a patent applicant and the scope of enablement set forth in the patent application. *In re Fischer*, 427 F. 2d 833, 839; 166 USPQ 18, 24 (CCPA 1970).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-25 and 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zajac (3,166,506) and Beretvas (3,255,109), considered separately.

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Zajac discloses lubricant greases comprising a major amount of a base oil such as mineral oils and synthetic oils, and 1-20 % by weight of an aromatic polyisocyanate which acts as a thickener. The aromatic polyisocyanate includes diphenyl-methane-4,4'-diisocyanate. See column 1, lines 18-31. The examiner is of the position that Zajac meets the limitations of the compositions set forth in claims 1, 15 and 44. The intended use language "useful for diesel engine" carries no weight in the claims. The above rejected claims are drawn to lubricating oil compositions comprising (1) a base oil and (2) at least one oil-dispersible source of NHCO which includes the isocyanate compound methylene diphenyl diisocyanate.

Beretvas discloses grease compositions comprising a major amount of a base oil such as mineral oil and synthetic oil, and an aromatic diisocyanate compound including diphenyl methane-4,4'-diisocyanate. See column 2, lines 11-28. The examiner is of the position that Beretvas also meets the limitations of the compositions set forth in claims 1, 15 and 44. The intended use language "useful for diesel engine" carries no weight in the claim. The above rejected claims are drawn to compositions comprising (1) a base oil and (2) at least one oil-dispersible source of NHCO which includes the isocyanate compound methylene diphenyl diisocyanate.

Claims 1-6, 14-17, 25-27, 29, 31, 34-35 and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farng et al (5,282,988).

Farng et al ["Farng"] discloses antiwear, antioxidant and rust inhibiting additives for lubricants. Farng teaches that wear is most serious in internal combustion engines such as diesel

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engines in which metal parts are exposed to sliding, rolling and other types of forceful, frictional mechanical contact. See column 1, line 12-39 and column 7, lines 52-66. Farnig discloses a urethane reaction product derived from an alkoxyated diorgano phosphorodithioate and an isocyanate. See column 4, lines 3-25. Farnig teaches that the reaction products are most effective when blended with lubricants in a concentration of about 0.01% to 10% by weight of the total composition. The examiner is of the position that formula (5) in column 4 meets the limitations of the above rejected claims of "at least one oil-dispersible source of HNCO".

Allowable Subject Matter

Claims 47-49 are allowed over the prior art references of record.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

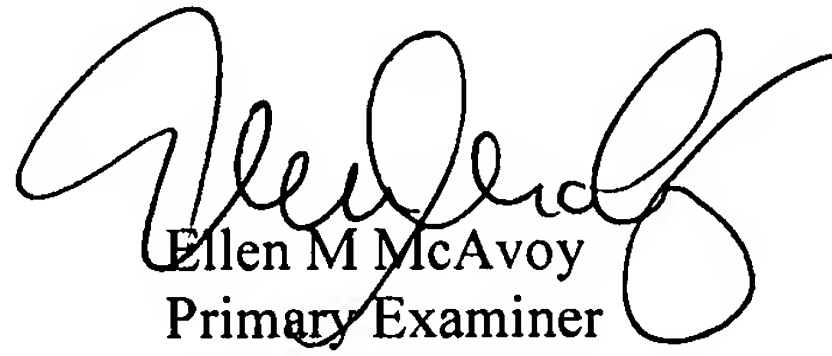
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451.

The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ellen M McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
August 7, 2006